

**BEFORE THE U.S. PATENT & TRADEMARK OFFICE
BOARD OF APPEALS AND INTERFERENCES**

In re application of: **Tarulis, George**

Serial No.: **10/706,370**

Group Art Unit: **3781**

Filed: **November 12, 2003**

Examiner: **Braden, Shawn M.**

For: **Drawn Wall Ironed Can for Light Colored Fruits**

Mail Stop Appeal Brief- Patents
Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICANT'S BRIEF ON APPEAL

Sir:

This is an appeal from the Office Action dated May 16, 2007 and the Advisory Action dated August 27, 2007. Appellant, Crown Cork & Seal Company, Inc, respectfully submits that the rejections therein were in error, and should be overturned upon *de novo* review, for the reasons set forth herein.

I. The Real Party in Interest

The Real Party in Interest is Crown Cork & Seal Company, Inc.

II. Related Appeals and Interferences

There are no related Appeals or Interferences.

III. The Status of the Claims

Claims 1, 3, 4, 22 and 23 are pending in this application. Claims 1, 3, 4, 22 and 23 stand rejected. Claims 2 and 5-21 have been canceled. The rejection of claims 1, 3, 4, 22 and 23 is being appealed.

IV. The Status of Amendments

No amendment to the claims was filed in the response dated August 16, 2007.

V. Summary of Claimed Subject Matter

With respect to claim 1, an embodiment of the invention can be a DWI can 10 for packaging light colored fruits and vegetables, comprising: a bottom 12 and a sidewall 14 integral with the bottom 12. See *the Specification*, Page 3 and Fig. 3. The sidewall 14 further comprises a steel substrate 20, a first coating 34 comprising tin on an outer surface thereof and a second unbreached, intact coating 36 comprising tin on an inner surface thereof. See *the Specification*, page 5, and Fig. 4. The second unbreached, intact coating 36 has a mass per unit area that is at least 0.20 pounds of tin per base box. See *the Specification*, page 5. The sidewall 14 further comprises no additional protective coating on the unbreached, intact second coating. See *the Specification*, page 5. The DWI can also has a top end 16 secured to the sidewall 14, wherein the sidewall 14 is fabricated by a drawn wall ironing process from a tin coated steel substrate. See the *Specification*, pages 4 and 5, and FIG. 3.

With respect to claims 3 and 23, an embodiment of the present invention can be a DWI can be 10 having second coating 36 that has a mass per unit area that is at least 0.25 pounds of tin per base box is disclosed. See *the Specification*, page 5.

With respect to claim 4, an embodiment of the present invention can be a DWI can be a DWI can 10 having a second coating 36 that is thicker than the first coating 34. See *the Specification*, page 5.

With respect to claim 22, one embodiment of the invention may be a DWI can 10 containing a light colored fruit or vegetable, comprising: a DWI can 10 having a bottom 12; a sidewall 14 integral with the bottom 12. See *the Specification*, Page 3 and Fig. 3. The sidewall 14 comprising: a steel substrate 20; a first coating 34 on an outer surface of said sidewall 14, the first coating 34 comprising tin and having a first thickness. See *the Specification*, page 5, and Fig. 4. A second unbreached, intact coating 36 on an inner surface of the sidewall 14 that defines an internal space of the DWI can 10, the second unbreached, intact coating 36 having a second thickness that is greater than the first thickness and comprises tin. See *the Specification*, page 5. The second unbreached, intact coating 36 has a mass per unit area that is at least 0.20 pounds of tin per base box. See *the Specification*, page 5. The sidewall 14 further comprises no additional protective coating on said second coating; a top end 16 secured to the sidewall 14 and a light colored fruit or vegetable disposed within the internal space of the DWI can. See *the Specification*, page 5.

VI. Grounds of Rejection to be Reviewed on Appeal

The Appellant believes that the various issues to be considered on appeal may be concisely enumerated and summarized as follows:

Issue 1: Have claims 1, 3, 4, 22 and 23 been improperly rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,095,544 to Peters et al. (hereinafter "Peters") in view of U.S. Patent No. 4,466,553 to Zenger (hereinafter "Zenger")?

VII. Argument -- The Rejections and Appellant's Response

Issue 1: Have claims 1, 3, 4, 22 and 23 been improperly rejected under 35 U.S.C. 103(a) as being unpatentable over Peters in view of Zenger?

1. Claim 1.

Claim 1 is an independent claim and is reproduced as follows for the convenience of the Examiners-in-Chief:

1. A DWI can for packaging light colored fruits and vegetables, comprising:

a bottom;

a sidewall integral with said bottom, said sidewall comprising a steel substrate, a first coating comprising tin on an outer surface thereof and a second unbreached, intact coating comprising tin on an inner surface thereof, said second unbreached, intact coating having a mass per unit area that is at least 0.20 pounds of tin per base box, said sidewall further comprising no additional protective coating on said unbreached, intact second coating; and

a top end secured to said sidewall,

wherein said sidewall is fabricated by a drawn wall ironing process from a tin coated steel substrate.

Claim 1 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Peters in view of Zenger.

"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an

independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).” See MPEP 2143.03.

Peters teaches a method for producing a corrosion resistant can from tinplate. The focus of the patent is that in order to improve corrosion resistance, Peters teaches heating the cold formed cup to a temperature above 400° F. See *Peters*, the Abstract and Col. 1, lines 60-63. The process teaches using a starting stock of a planar sheet of steel having a coating of at least 0.25 pounds of tin per base box. See *Peters*, col. 1, lines 49-52. Elsewhere, it is suggested that one of the layers of the starting stock can be coated with 0.75 pounds of tin per base box. See *Peters*, Col. 2, lines 43-46 and Col. 7, lines 4-7. Nowhere in *Peters* is it disclosed what the pounds of tin per base box of the sidewalls are after the can is made. In fact, it is suggested in various places that the drawn sidewalls are reduced in thickness as part of the method of making of the can. See *Peters*, Col. 3, lines 35-36 and lines 58-63.

Only one reference is made in *Peters* regarding the thickness of a finished can and that is with respect to the bottom portion of the can and not to the sidewalls. *Peters* states “the bottom wall of the cup produced is of the same thickness as the starting stock but the sidewalls are reduced in thickness by the ironing step or steps.” See *Peters*, Col. 3, lines 32-36. In this instance the thickness of the bottom portion remains the same only because bottom portion is sheared in the starting stock prior to the ironing process and therefore the bottom portion is not subjected to the same process that the sidewalls are. See *Peters*, Col. 3, lines 41-64. No mention is made within *Peters* as to the thickness of the sidewalls of the finished can.

Additionally, it is noted that the finished product in *Peters* has more than one layer for the sidewall. As shown in FIG. 13, in the finished product there is a layer 26 and a layer 28 on the base metal 20. As a result of the process the layers 26 and 28 are fractured. See *Peters*, Col. 6, lines 35-41. As a result of the heat treatment, the corrosion resistance of the sidewall 19 is restored as shown in FIG. 15. See *Peters*, Col. 6, lines 58-65. Therefore, finished sidewall 19 has a steel substrate 20, a layer 26, a layer 28 and on top of those layers, layers 22 and 24 of tin. *Peters* does not disclose having no additional protective coating on the unbreached, intact second coating, since layers 22 and 24 are clearly additional protective coatings on the breached layers 26 and 28.

Zenger is directed towards a composite container. The container has a liner contained within to seal food products. See *Zenger*, the Abstract. Generally speaking, the containers described in *Zenger* are directed towards thermoformed plastic containers. See *Zenger*, Col. 4, lines 63-65 and Col. 5, lines 36-43. There is some discussion of metal containers; however *Zenger* never mentions the pounds of tin per base box of a finished container. *Zenger* is merely used in the Office Action to provide teaching of storing vegetables.

Claim 1 is directed to a DWI can for packaging light colored fruits and vegetables. The claim language is directed towards the can after it has been constructed and not to the starting stock. Independent claim 1 requires, *inter alia*, “a second unbreached, intact coating comprising tin on an inner surface thereof, said second unbreached, intact coating having a mass per unit area that is at least 0.20 pounds of tin per base box, said sidewall further comprising no additional protective coating on said unbreached.”

Neither Peters nor *Zenger* discloses or teaches having an inner coating of tin that is at least 0.20 pounds of tin per base box in the finished can. Peters suggests pounds of tin per base box for starting stock but not for finished cans. *Zenger* simply does not have relevant teaching directed towards pounds of tin per base box for sidewalls. It is not known what effect the manufacturing process and heat treatment taught by Peters will have on the pounds of tin per base box. Furthermore, it is improper for the Office Action to speculate what the effect would be without more information related to the effects of the process taught by Peters. Additionally, the Office Action does not even suggest a rationale to explain the discrepancy.

In the Advisory Action, mailed August 8, 2007, the Examiner states the following:

“Peters discloses using “a coating of at least .25 lb tin per BB” col 1 ln 50 and in a particular embodiment starting with .75 lb per BB col 2 ln 43. Applicant has stated no further evidence stating that this base material would thin to below .20 lb per bb. Examiner will uphold rejection. It would be well within the skill of one with ordinary skill in the art to start out with 1 or 1.25 or 1.5 lb per base thus guaranteeing a final thickness of .20 lb per bb.”

The Examiner in the Advisory Action is improperly trying to shift the burden of proof from the Office to the Appellant. Without first establishing a *prima facie* case for obviousness, the Examiner is suggesting that the Appellant prove that features of Peters that are clearly not shown in Peters are not there. This is clearly impermissible. Furthermore, the Advisory Action is also improperly trying to present new grounds of rejections without removing Final status.

Claim 1 also requires, *inter alia*, that “said sidewall further compris[es] no additional protective coating on said unbreached, intact second coating.” As discussed above, finished sidewall 19 has a steel substrate 20, a layer 26 and a layer 28 on top of the substrate 20 and on top of those layers, a layer 22 and a layer 24 of tin. See *Peters*, FIGS. 13-15. *Peters* is clearly showing having an additional protective coating on a second coating, since layers 22 and 24 are clearly additional protective coatings on the breached layers 26 and 28. *Peters* also mentions that as a result of the process the layers 26 and 28 are fractured, thus suggesting that the coating is both breached and non-intact. See *Peters*, Col. 6, lines 35-41. Zenger does not correct this deficiency.

Therefore, a *prima facie* case for obviousness has not been established for claim 1 since each and every limitation of claim 1 is not met by the either *Peters* or Zenger, alone or in combination.

2. Claims 3 and 23

Claims 3 and 23 require that the “second coating ha[ve] a mass per unit area that is at least 0.25 pounds of tin per base box.” In order to provide teaching for this limitation the Office Action points Col. 2, line 44 of *Peters*. As discussed above this section in *Peters* discusses the pounds of tin per base box for starting stock but not for finished cans. Since *Peters* does not teach “having a mass per unit area that is at least 0.20 pounds of tin per base” it similarly fails to teach having a mass per unit area that is at least 0.25 pounds of tin per base box. This additional standard makes the speculation exhibited by the Examiner in the Advisory Action even more unlikely. For at least this additional reason, claims 3 and 23 should be allowed.

3. Claim 4

Claim 4, requires that the “second coating [be] thicker than said first coating.” The Office Action points to Col. 2, lines 43-45 of Peters in order to provide teaching for this limitation. As discussed above, that section points to the thicknesses for the starting stock and not for the finished can. There is no teaching in Peters as to thicknesses for the first and second coating after the process. For at least this additional reason, claim 4 should be allowed.

4. Claim 22

Claim 22 is an independent claim and is reproduced as follows for the convenience of the Examiners-in-Chief:

22. A DWI can containing a light colored fruit or vegetable, comprising:

- a DWI can having a bottom;
- a sidewall integral with said bottom, said sidewall comprising:
 - a steel substrate;
 - a first coating on an outer surface of said sidewall, said first coating comprising tin and having a first thickness; and
 - a second unbreached, intact coating on an inner surface of said sidewall that defines an internal space of said DWI can, said second unbreached, intact coating having a second thickness that is greater than said first thickness and comprises tin, said second unbreached, intact coating having a mass per unit area that is at least 0.20 pounds of tin per base box, said sidewall further comprising no additional protective coating on said second coating;
- a top end secured to said sidewall; and
- a light colored fruit or vegetable disposed within said internal space of said DWI can.

As discussed above with respect to claim 1, independent claim 22 requires *inter alia* a “second unbreached, intact coating having a second thickness that is greater than said first thickness and comprises tin, said second unbreached, intact coating having a mass per unit area that is at least 0.20 pounds of tin per base box, said sidewall further comprising no additional protective coating on said second coating.” For those reasons discussed above with respect to claim 1, claim 22 is also in condition for allowance. Claim 23 is also in condition for allowance by virtue of its dependence upon an allowable base claim.

Therefore, the Appellant respectfully submits that a *prima facie* case for obviousness has not been established since each and every limitation of the claims has not been met by either Peters or Zenger, alone or in combination. Furthermore, attempts by the Examiner to justify the combination post finalization are also improper. The Appellant respectfully requests allowance of all pending claims.

Respectfully submitted,

/Tod A. Kupstas/

Date: December 12, 2007

Tod A. Kupstas
Registration No. 54, 917

KNOBLE YOSHIDA & DUNLEAVY, LLC
Eight Penn Center- Suite 1350
1628 John F. Kennedy Boulevard
Philadelphia, PA 19103
(215) 599-0600 Telephone
(215) 599-0601 Facsimile
takupstas@patentwise.com

VIII. APPENDIX- CLAIMS ON APPEAL

1. A DWI can for packaging light colored fruits and vegetables, comprising:

a bottom;

a sidewall integral with said bottom, said sidewall comprising a steel substrate, a first coating comprising tin on an outer surface thereof and a second unbreached, intact coating comprising tin on an inner surface thereof, said second unbreached, intact coating having a mass per unit area that is at least 0.20 pounds of tin per base box, said sidewall further comprising no additional protective coating on said unbreached, intact second coating; and

a top end secured to said sidewall,

wherein said sidewall is fabricated by a drawn wall ironing process from a tin coated steel substrate.

Claim 2 (Canceled).

3. A DWI can according to claim 1, wherein said second coating has a mass per unit area that is at least 0.25 pounds of tin per base box.

4. A DWI can according to claim 1, wherein said second coating is thicker than said first coating.

Claims 5-21 (Canceled).

22. A DWI can containing a light colored fruit or vegetable, comprising:

a DWI can having a bottom;

a sidewall integral with said bottom, said sidewall comprising:

a steel substrate;

a first coating on an outer surface of said sidewall, said first coating comprising tin and having a first thickness; and

a second unbreached, intact coating on an inner surface of said sidewall that defines an internal space of said DWI can, said second unbreached, intact coating having a second thickness that is greater than said first thickness and comprises tin, said second unbreached, intact coating having a mass per unit area that is at least 0.20 pounds of tin per base box, said sidewall further comprising no additional protective coating on said second coating;

a top end secured to said sidewall; and

a light colored fruit or vegetable disposed within said internal space of said DWI can.

23. A DWI can according to claim 22, wherein said second coating has a mass per unit area that is at least 0.25 pounds of tin per base box.

IX. EVIDENCE APPENDIX

There have been no submissions of evidence under 37 C.F.R. §§ 1.130, 1.131 or 1.132 in this application.

X. RELATED PROCEEDINGS APPENDIX

There have been no related decisions rendered by a court or the USPTO Board of Appeal and Interferences in this matter.